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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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| 09/549,928 | 04/14/00 | DELPLANCHE | 32232-159912 |

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| EXAMINER |
|-----------|
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| ART UNIT | PAPER NUMBER |
|----------|--------------|
| 1714 | 6 |

DATE MAILED: 08/03/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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Office Action Summary

Application No.

09/549,928

Applicant(s)

DELPLANCHE ET AL.

Examiner

Margaret B. Medley

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 1-7, 15 and 16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 8, 9, 14 and 17 is/are rejected.
- 7) ☒ Claim(s) 10-13 and 18 is/are objected to.
- 8) ☐ Claims ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

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DETAILED ACTION

Claim 18 is objected to because of the following informalities: The spelling of "nitrophenyloxycarbonyl phenyl alanine" should be corrected in line 2. Appropriate correction is required.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 8-9, 14 and 17 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Gary et al "Preparation and Properties of Some alpha Azo-amino-acid Derivatives, Their Possible Use in Peptide Synthesis", note compound 5 of page 741 column 1, lines 6+ for "2,4-dinitrophenyloxycarbonyl phenyl alanine" which anticipates the claimed reagents.

Claims 8-9, 14 and 17 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Ryono et al 4,885,292.

Note column 35 lines 47-59 for a solution comprising N-[(4-Nitrophenoxy)carbonyl]-L-phenyl alanine, methyl ester that clearly anticipates the claimed compounds and solution comprising said compounds.

Claims 8-9, 14 and 17 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Patel 5,217,958.

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Note column 22 for compounds LXIV and LXVIII and column 82 lines for the compound A. N-[(4-Nitrophenoxy)carbonyl]-L-phenyl alanine, methyl ester and a solution containing said compound that clearly anticipate the claimed compounds and solution comprising said compounds.

Claims 8-9, 14 and 17 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Norbeck et al 5, 461,067

Note column 33 lines 15-28 for the compound D. N-(((4-Nitrophenyl)oxy)carbonyl)-L-valine Methyl Ester and solution comprising said compound that clearly anticipates the claimed compound and solution comprising said compound.

Claims 8-9, 14 and 17 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by 5,484,801

Note column 17, line 55-end for compound R. N-(((4-Nitrophenyl)oxy)carbonyl)-L-valine Methyl Ester and solution comprising said compound that clearly anticipate the claimed compound and solution comprising said compound.

The restriction requirement is proper for reasons made of record in Paper No. 4 dated April 9, 2001.

Claims 10-13 and 18 appear to contain allowable subject matter and would be allowed if written in independent claim form including all of the limitation of its intervening claims.

The prior art cited but not applied further teach reagents of the same nature as claimed by applicants.

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Any inquiry concerning this communication should be directed to Margaret B.

Medley at telephone number 703-308-2518

MBMedly

August 02, 2001.


MARGARET MEDLEY
PRIMARY EXAMINER